REMARKS

Claims 1-7, 9-16 and 18-21 are pending in the present application. Claims 8 and 17 are canceled and claims 1, 7, 11, 12, 14, 15, 16, 18, 19, 20 and 21 are amended. Claims 1, 11, 18, 19, 20 and 21 are amended for clarification and to further define the claims. Support for the amendments to claims 1, 7, 11, 14, 18, 19, 20 and 21 may be found at least on page 13, line 20 through page 14, line 18. Support for the amendment to claim 15 may be found at least on page 16, line 24 through page 17, line 11. Reconsideration of the claims is respectfully requested.

I.   35 U.S.C. § 102, Alleged Anticipation Based on *Graham*

The Office Action rejects claims 1-21 under 35 U.S.C. § 102(e) as being allegedly anticipated by *Graham et. al.* (U.S. Patent Number 6,457,026 B1), hereinafter referred to as *Graham*. This rejection is respectfully traversed.

As to independent claims 1, 18, 20 and 21, the Office Action states:

With regard to claims 1, 18 and 21:
     Graham et al ("Graham") discloses a computer-implemented method for researching highlighted or annotated text in an electronically stored document (or electronic book), which contains plurality of pages including table of contents (see Figs. 2A-2D, 3, 4, 9A and 9B).
     The method includes among other things, receiving a user input via an input device (Fig. 1, #36) selecting the text from the electronic document to form selected text (see Fig. 2B, #220, Fig. 2C, #224, or Fig. 2D, #226, column 3, lines 56-66, column 4, lines 3-28).
     The method also includes automatic web search process (automatically initiating a search), wherein when this web search process is enabled (via user input), whenever a particular keyword or key phrase is found frequently near where a defined concept is determined to be discussed, a web search tool such as Alta Vista™ is employed to look on the World Wide Web for documents containing the keyword (the selected text) or key phrase (column 7, lines 46-57).
     ...

With regard to claims 20:
     Graham discloses a data processing system (Fig. 1, #10) comprising: a bus system (12); a communication unit (40) connected to the bus system; a memory (16) connected to the bus system, wherein the memory includes a set of instructions.
     Graham further discloses a processing unit (14) connected to the bus system, wherein the processing unit executes the set of instruction to receiving a

user input (30 and 36) selecting the text from the electronic book to form selected text (see Fig. 2B, #220, Fig. 2C, #224, or Fig. 2D, #226).

Graham also discloses automatic web search process (automatically initiating a search) (column 7, lines 46-57), wherein when this web search process is enabled (via user input), whenever a particular keyword or key phrase is found frequently near where a defined concept is determined to be discussed, a web search tool such as Alta Vista™ is employed to look on the World Wide Web for documents containing the keyword (the selected text) or key phrase (column 7, lines 46-57).

Office Action dated June 25, 2004, page 3 and pages 7-8.

As amended, claim 1, which is representative of the other rejected independent claims 18, 20 and 21 with regard to similarly recited subject matter, reads as follows:

> 1. A method in a data processing system for researching text in an electronic book, the method comprising:
> receiving a user input selecting the text from the electronic book, wherein the user input tags a beginning point and an ending point of any portion of text in the electronic book to form selected text and wherein the selected text is identified by a user after the electronic book is displayed; and
> automatically initiating a search for at least one item relevant to the selected text in response to receiving the user input. (emphasis added)

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Applicants respectfully submit that *Graham* does not identically show every element of the claimed invention arranged as they are in the claims. Specifically, *Graham* does not teach or suggest receiving a user input selecting the text from an electronic book, wherein the user input tags a beginning point and an ending point of any portion of text in the electronic book to form selected text and wherein the selected text is identified by a user after the electronic book is displayed or automatically initiating a search for at least one

item relevant to the selected text <u>in response to receiving the user input</u>, as recited in independent claims 1, 18, 20 and 21.

Graham is directed toward an automatic reading assistance application for documents in electronic form. An automatic annotator finds concepts of interest and keywords in an electronic document based on the contents of a user profile. The concepts of interest and other user-specific information are maintained in a user profile. The user employs a profile editor to modify the contents of the user profile. When a user opens an electronic document, the electronic document is automatically annotated by highlighting phrases within the electronic document that relate to the concepts of interest and keyword contained in the user profile.

Claims 1, 18, 20 and 21 of the present application recite automatically initiating a search for at least one item relevant to the selected text <u>in response to receiving the user input</u>. The user input tags a beginning point and an ending point of any portion of text in the electronic book to form selected text and the selected text is identified by a user after the electronic book is displayed. To the contrary, *Graham* teaches <u>highlighting</u> keywords in an electronic document based on the contents of a <u>user profile</u>. Further, *Graham's* web autofetch feature only searches for keywords in a <u>user profile</u>. *Graham* provides no ability for a user to select a portion of a displayed electronic book, by tagging a beginning point and an end point, and then initiate a search for an item relevant to the selected portion of text. To the contrary, *Graham* teaches an opposite operation in which portions of a displayed text that are relevant to a user profile are highlighted automatically.

The Office Action refers to the following portion of *Graham* in the rejection of independent claims 1, 18, 20 and 21:

> FIG. 2B depicts the document view of FIG. 2A but with annotation added in first viewing area 202. <u>Phrases 220 have been highlighted to indicate that they relate to concepts of interest to the user</u>. The highlighting is preferably color. However, for ease of illustration in black-and-white format, rectangles indicate the highlighted areas of text. For further emphasis, the highlighted text is preferably printed in bold. A rectangular bar 222 indicates a paragraph that has been determined to have relevance above a predetermined threshold or to have more than a threshold number of key phrases. Rectangular bar 222 is merely representative of <u>various forms of marginal annotation</u> that might be used to indicate a relevant section of the text.
> FIG. 2C depicts an <u>alternative style of annotation</u>. Now in first viewing area 202, entire sentences 224 including phrases relevant to concepts of interest

are highlighted. The phrases themselves are printed in bold text. It has been found that highlighting the entire sentence rather than just a relevant phrase provides the user with far more information at a glance.

FIG. 2D depicts how further information about key phrases may be displayed. The user may select any highlighted key phrase with the mouse. Upon selection of the key phrase, a balloon 226 appears. The balloon includes further information relevant to the key phrase. For example, the balloon may include the name of the concept to which the keyword is relevant. The balloon may also include bibliographic information if the key phrase includes a citation.

FIG. 3 depicts a document summary view in accordance with one embodiment of the present invention. The user may optionally select a summary view 300 of the document. Summary view lists the concepts of interest 302 that are found in the documents as headings of an outline. For each concept, keywords or key phrases 304 are listed which are indicative of the concept of interest. A number in parenthesis by each keyword indicates the number of times the keyword or key phrase appears. Each concept also has an associated score 306 indicative of the relevance of the whole document to the concept.

Graham, column 3, line 56 through column 4, line 28.

This portion of *Graham* teaches that the automatic annotation of the electronic document may include a variety of formats as shown in Figures 2B and 2C. The annotation taught by *Graham* is performed automatically based on the contents of a user profile. *Graham* teaches that a user may select an already annotated (highlighted) keyword in the electronic document with a mouse to display a balloon that contains addition information for the keyword, such as the concept name associated with the keyword from the user profile. *Graham* also teaches that a summary view of the document can be generated which contains an outline of the concepts of interest and keywords found in the document. *Graham* does not teach or suggest that a user can select any portion of text from an electronic document after the electronic document is displayed and automatically searching for items relevant to the selected text in response to the user input selecting the text.

The following portion of *Graham* describes the processing of an annotation agent:

The processing of annotation agent 508 is preferably a run-time process. The annotations are not preferably pre-inserted into the text but are rather generated when user 504 requests document 502 for browsing. Thus, this is preferably a dynamic process. Annotation agent 508 may also, however, operate in the background as a batch process.

The annotation added by annotation agent 508 depends on concepts of interest selected by user 504. User 504 also inputs information used by annotation

agent 508 to identify locations of discussion of concepts of interest in document 502. In a preferred embodiment, this information defines the structure of a Bayesian belief network. The concepts of interest and other user-specific information are maintained in a user profile file 516. User 504 employs a profile editor 518 to modify the contents of user profile file 516.

Graham, column 5, lines 3-16.

This portion of *Graham* shows that annotations are generated when a user opens a document for browsing and that the annotation depends on the selected concepts of interest maintained in a user profile file. Thus, *Graham* only teaches automatic annotating based on the contents of a user profile. *Graham* does not teach that a user tags a beginning point and an ending point of any portion of text in the electronic book and this user input is used in the automatic search for items relevant to the selected text.

The Office Action refers to the following portion of *Graham* in the rejection of independent claims 1, 18, 20 and 21:

> By selecting whether a background learning checkbox 836 has been selected, the user may enable or disable the operation of profile updating stage 624. A web autofetch check box 838 permits the user to select whether or not to enable an automatic web search process. When this web search process is enabled, whenever a particular keyword or key phrase is found frequently near where a defined concept is determined to be discussed, a web search tool such as Alta Vista™ is employed to look on the World Wide Web for documents containing the keyword or key phrase. A threshold slider control 840 is provided to enable the user to set a threshold relevance level for this autofetching process.

Graham, column 7, lines 46-57.

This portion of *Graham* only teaches that a user interface has an automatic web search process, which a user may enable or disable. *Graham* does not teach or suggest automatically initiating a search for at least one item relevant to the selected text in response to receiving the user input, as recited in claims 1, 18, 20 and 21. As stated previously, the user input tags a beginning point and an ending point of any portion of text in the electronic book to form selected text and the selected text is identified by a user after the electronic book is displayed. To the contrary, *Graham's* web search is based on the contents of a user profile. A keyword or key phrase from the user profile, that is found when a document is opened for browsing, may initiate an automatic web search process if the keyword or key phrase is found frequently near a defined concept.

The search is <u>not</u> in response to receiving user input as recited in claims 1, 18, 20 and 21.

Thus, Graham does not teach or suggest the features of claims 1, 18, 20 and 21.

As to independent claims 11 and 19, the Office Action states:

<u>With regard to claims 11 and 19</u>:

Graham discloses a computer-implemented method for researching highlighted or annotated text in an electronically stored document (or electronic book), which contains plurality of pages including table of contents (see Figs. 2A-2D, 3, 4, 9A and 9B).

The method includes among other things, responsive to a selecting the highlighted text (see Fig. 2B, #220, Fig. 2C, #224, or Fig. 2D, #226, column 3, lines 56-66, column 4, lines 3-28) within the document, preparing and transmitting (via document browser 506) the selected highlighted text to be searched by a web search tool such as such as Alta Vista^{TM} (column 7, lines 46-57).

The method further includes receiving (via document browser 506) the search result from the web search (column 7, lines 46-57).

Office Action dated June 25, 2004, pages 5-6.

As amended, claim 11, which is representative of the other rejected independent claims 19 with regard to similarly recited subject matter, reads as follows:

11.   A method in a data processing system for searching text, the method comprising:
        <u>designating the text to use in a search based on a user selected beginning point and a user selected ending point of any portion of text located in an electronic document</u>;
        responsive to designating the text in the electronic document to use in the search, placing the text in a data structure, wherein the data structure is a search profile;
        transmitting the data structure to a search engine; and
        receiving results from the search engine. (emphasis added)

The Office Action refers to the same portions of *Graham* in the rejection of independent claims 11 and 19. *Graham* does not teach or suggest designating the text to use in a search based on a user selected beginning point and a user selected ending point of any portion of text located in an electronic document. To the contrary, *Graham* only teaches automatically searching for keywords <u>in a user profile</u>. As discussed above, *Graham* only searches the web for keywords or key phrases in a <u>user profile</u> if the keywords or key phrases are found frequently near where a defined concept is determined to be discussed. The concept is defined in a <u>user profile file</u>. *Graham* does not teach or

suggest a method for any selected portion of text to be used in a search. To the contrary, only frequently found keywords or key phrases may initiate the automatic autofetch function of Graham. Thus, Graham does not teach or suggest the features of claims 11 and 19.

In view of the above, Applicants respectfully submit that *Graham* does not teach each and every feature of independent claims 1, 11, 18, 19, 20 and 21, as is required under 35 U.S.C § 102(e). At least by virtue of their dependency on claims 1 and 11, respectively, *Graham* does not teach each and every feature of dependent claims 2-7, 9-10 and 12-16. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-7, 9-16 and 18-21 under 35 U.S.C § 102(e).

Furthermore, *Graham* does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. *Graham* actually teaches away from the presently claimed invention because it teaches annotating text and searching for text related to concepts and keywords in a user profile opposed to a user selecting any portion of text in an electronic document and automatically searching for items relevant to the selected text in response to the user selecting the text as in the presently claimed invention. Absent the Examiner pointing out some teaching or incentive to implement *Graham* and method for a user to select any portion of text in an electronic document and automatically searching for items relevant to the selected text in response to the user selecting the text, one of ordinary skill in the art would not be led to modify *Graham* to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify *Graham* in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the Applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

In addition to the above, *Graham* does not teach the specific features recited in dependent claims 2-7, 9-10 and 12-16. For example, with regard to claims 7 and 12, *Graham* does not teach that the selected text is a user created note associated with at least a portion of the electronic book. The specification of the present invention on page 14, lines 9-18, states that a note contains text, such as comments about a portion of the electronic book or references related to the electronic book. A note can be associated
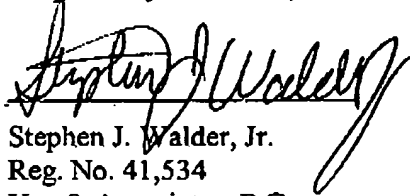
with a portion of the electronic book or the entire electronic book. Claim 7 is amended to clarify a notated passage of text. Claim 12 is amended to contain similar subject matter as claim 7. *Graham* does not teach, suggest or mention creating notes for an electronic document or using the text from a note in a search. Claims 2-6, 9-10 and 13-16 recite other features which, when taken in combination with claims 1 and 11, are not taught or suggested by *Graham*.

II. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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